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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,037	10/15/2003	Erich Kast	BE-119	4999

7590  
Friedrich Kueffner  
Suite 910  
317 Madison Avenue  
New York, NY 10017

10/16/2007

EXAMINER
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COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/686,037  
Filing Date: October 15, 2003  
Appellant(s): KAST ET AL.

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Friedrich Kueffner  
For Appellant

**MAILED**  
**OCT 16 2007**  
**GROUP 3700**

**EXAMINER'S ANSWER**

This is a substitute Examiner Answer in response to the Appeal Brief filed 20 January 2006 appealing from the Office action mailed 23 March 2005. The Examiner's Answer forwarded to the Board of Patent Appeals and Interferences on 03 May 2006 is hereby vacated in favor of the present substitute Examiner's Answer, which has been revised to explicitly recite the grounds of rejection rather than incorporate them by reference.

**(1) Real Party in Interest**

The statement of the real party in interest contained in the brief is correct.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement regarding the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Bernard et al. (FR 2 795 945 A1; *cf. corresponding* US 6,964,687 B1 and US 2005/0125029 A1).

**(9) Grounds of Rejection**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernard et al. (FR 2 795 945).

Bernard discloses an implant 1 having a height that increases from a ventral side 5 to a dorsal side 4 to a maximum height and then decreases again (see Figs. 1-3). The maximum height is located in a last third of a length of the implant (see esp. Fig. 3). The implant has a height that increases from its outer extents toward a center axis in a direction perpendicular to a center axis passing through the spine from front to back. The implant is symmetrically shaped with respect to a plane that perpendicularly intersects a longitudinal axis of the spine. The implant includes projections 11. The

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anterior end face 5 has a generally convex shape, i.e. outwardly curving, at least when taken between the planar side walls, e.g. 2 (see Fig. 1). The implant has a hollow, cage-like configuration with wall openings 20. When viewed from above it has a frame-like configuration with an opening therein to the upper side and the lower side (see Fig. 1).

### **(10) Response to Argument**

In response to appellant's argument that the implant of Bernard does not have a maximum height in the last third thereof, facing the chest of a patient, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Thus, if the structure of the implant of Bernard et al. is at least capable of performing the intended use of appellant's implant, as set forth in appellant's claims, then it meets the limitations of the claims. Specifically, if the implant of Bernard et al. is at least capable of being turned around (i.e. 180°) before being inserted between adjacent vertebrae, then it meets the claims, and the rejection under 35 USC 102(b) should be maintained. Of course, capability is not the same as what might be optimal or preferred. Obviously, the implant of Bernard et al. is intended to be inserted with a tool that engages the seats 20, 23, such that the maximum height of the implant would be in the first third of the implant rather than the last third, as viewed from the front of a vertebral column. However, this intended manner of use is

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not the only manner of use. For example, the implant is clearly at least capable of being grasped on any portion thereof with forceps or by hand and of being inserted into a vertebral space in any desired orientation including turned around 180 degrees.

Appellant's arguments clearly depend on the intended orientation of the device (e.g., with respect to the chest and the back). For example, see appellant's statement, beginning at page 6, line 13 of the brief:

"However, even if the maximum [height, sic] of the implant described by Bernard et al. were to be located in the last third *facing the chest*, and *this implant would then have structural features similar to those of the implant according to the present invention*, the reference does not disclose and cannot render obvious the present invention as claimed. The structural features of such implants can under no circumstances be taken into consideration separately from the *intended implant location*. The structural features of the implant described by Bernard et al. clearly do not display the technical teaching of the present invention which resides in that the maximum of the implant height is to be located in the last third which *fascies [sic] the back*." (examiner's emphasis)

In conclusion, it is believed that the structure and capability of the implant of Bernard et al. satisfy the claims.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this Examiner's Answer.

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For the above reasons, it is believed that the rejections should be maintained.


Respectfully submitted,

D. Comstock

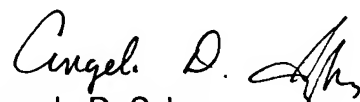


09 October 2007

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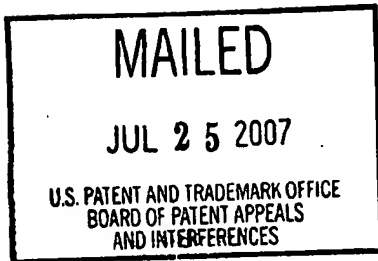


Eduardo Robert  
Supervisory Patent Examiner  
Art Unit 3733



Angela D. Sykes  
Supervisory Patent Examiner  
Art Unit 3762

UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERICH KAST, HANS-JOACHIM WILKE and PETER WEILAND

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Application 10/686,037

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on July 14, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

In section **"(9) Grounds of Rejection"**, p. 3 of the Examiner's Answer mailed May 3, 2006, instead of stating the Grounds of Rejections of the appealed claims, the Examiner has chosen to refer to the prior Office Action mailed on 23 March 2005 for an explanation of the rejected claims.



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The Manual Of Patent Examining Procedure (MPEP) 1207.02 (8<sup>th</sup> ed., Rev. 3 August 2005) which was controlling at the time the Answer was written, ( as well as the current MPEP revision) states in part:

If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR 41.39 by copying a rejection from a prior Office action and then pasting the copied rejection into the answer. *An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.* Of course, if the examiner feels that some further explanation of the rejection is necessary, he or she should include it in the ground of rejection set forth in the answer. (emphasis added.)

As per the above, it is no longer permissible to incorporate a prior Office action into an examiner's answer, simply by reference to the action alone. The action (or parts thereof) must be physically inserted into the answer. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the examiner to submit a revised Examiner's Answer alleviating the discrepancy noted above by vacating the answer and submitting a substitute Examiner's Answer that either:

- a.) contains a copy of the prior Office Action referenced in the Grounds of Rejection, (if the examiner wishes to maintain this course of action), or

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b.) fully restates the grounds of rejections of the appealed claim in the usual manner,  
and for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: *Patrick J. Nolan*  
PATRICK J. NOLAN  
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PJN/vsh

cc: FRIEDRICH KUEFFNER  
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7590 05/03/2006  
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317 Madison Avenue  
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EXAMINER

COMSTOCK, DAVID C

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DATE MAILED: 05/03/2006

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**MAILED**  
**MAY 03 2006**  
**Group 3700**

Friedrich Kueffner  
For Appellant

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**(9) Grounds of Rejection**

Examiner's grounds of rejection to be reviewed on appeal are contained in the final Office action mailed on 23 March 2005, at page 2.

**(10) Response to Argument**

Examiner's position and Response to Arguments are contained in the final Office action mailed on 23 March 2005 (see page 4, line 11 - page 5, line 2). It is again noted that if the structure of the implant of Bernard et al. is at least capable of performing the intended use of appellant's implant, as set forth in appellant's claims, then it meets the limitations of the claims. Thus, if the implant of Bernard et al. is at least capable of being turned around (i.e. 180°) before being inserted between adjacent vertebrae, then

it meets the claims, and the rejection under 35 USC 102(b) should be maintained. Of course, capability is not the same as what might be optimal or preferred. Obviously, the implant of Bernard et al. is intended to be inserted with a tool that engages the seats 20, 23, such that the maximum height of the implant would be in the first third of the implant rather than the last third, as viewed from the front of a vertebral column. However, this intended manner of use is not the only manner of use. For example, the implant is clearly at least capable of being grasped on any portion thereof with forceps and of being inserted into a vertebral space in any desired orientation.

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For the above reasons, it is believed that the rejections should be maintained.

Respectfully submitted,

DC



20 April 2006

Conferees:

Eduardo Robert  
Supervisory Patent Examiner  
Art Unit 3733



Angela D. Sykes  
Supervisory Patent Examiner  
Art Unit 3762

